

REMARKS

Applicants respectfully submit that the claims 1, 25, 26, 33, and 34 have been amended to more clearly point out the present invention. All the claims presently on file are in condition for allowance or appeal.

THE CLAIMS

REJECTION UNDER 325 USC 112

Claims 25 and 44 were rejected under 35 USC 112, first paragraph. It appears that the Examiner intended to reject claims 25 and 33 instead of claims 25 and 44. Applicants have amended claims 25 and 33 in satisfaction of 35 USC 112.

REJECTION UNDER 325 USC 102

Claims 1-3 and 21-37 were rejected under 35 U.S.C. 102(e) as being anticipated by Chang et al. (US 2004/0119740), hereinafter referred to as "Chang".

Applicants respectfully traverse this rejection and respectfully submit that Chang does not disclose all the elements and limitations of the rejected claims. Consequently, the claims on file are not anticipated under 35 U.S.C. 102, and the allowance of these claims is earnestly solicited. In support of this position, Applicants submit the following arguments:

A. Legal Standard for Lack of Novelty (Anticipation)

The standard for lack of novelty, that is, for "anticipation," is one of strict identity. To anticipate a claim for a patent, a **single prior source must contain** all its essential elements, and the burden of proving such anticipation is on the party making such assertion of anticipation. Anticipation cannot be shown by combining more than one reference to show the elements of the claimed invention. The amount of newness and usefulness need only be minuscule to avoid a finding of lack of novelty.

The following are two court opinions in support of Applicants' position of non anticipation, with emphasis added for clarity purposes:

- "Anticipation under Section 102 can be found only if a reference shows **exactly** what is claimed; where there are **differences** between the reference disclosures and the claim, a rejection must be based on obviousness under Section 103." *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).
- "**Absence** from a cited reference **of any element** of a claim of a patent negates anticipation of that claim by the reference." *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986), on rehearing, 231 USPQ 160 (Fed. Cir. 1986).

B. Independent Claims 1, 26, and 34 in Light of Chang

The allowance of independent claims 1, 26, and 34 will now be discussed in view of representative claim 1.

Chang generally describes a method for viewing and responding to electronic messages. When an electronic message is displayed, a portion of the electronic message is elided to aid in the viewing experience. The method generally includes identifying an extraneous portion within a second electronic message; eliding the extraneous portion within the second electronic message; and generating the first electronic message wherein the first electronic message includes the second electronic message with the extraneous portion of the second electronic message suppressed.

Chang elides a portion of a message by identifying an extraneous portion within the message. To identify an extraneous portion, Chang considers a message and analyzes its content to find the extraneous portion within the message. Even when the plurality of messages are targeted, each message is examined to identify an extraneous portion within the message.

Chang differs from the present invention in the way of implementing (or realizing) the expansion condition (expansion or collapse) of the thread in the virtual document. According to the present invention, the expansion condition of a message (or messages) is based on the structure of thread. The present invention does not analyze the content of the documents, to effect the expansion condition.

Though Chang refers to a "thread", it does not describe the handling of the tree structure of the thread. Chang seems to use a simple thread in

which all the messages are posted in chronological order, without branching out. In such a thread, messages can be shown in a flat view, and eliding extraneous portion of each message is useful to extract essential information in the thread. However, in a tree thread, messages cannot be shown in a flat view, and therefore, eliding extraneous portions of each message would not be useful.

Chang does not describe a process or a system for displaying documents by extracting a relationship between a plurality of documents in the group of documents and generating a virtual document from a plurality of documents.

In response to this argument, the Examiner indicates that: "The thread itself is a virtual document that is made from a plurality of documents." In other terms, the Examiner seems to equate a thread to a virtual document.

Contrary to Chang and to the Examiner's rejection ground, the present application clearly explains, in paragraph [0059], that the virtual document is generated by combining documents within a thread. In other terms, the thread is not the same component as the virtual document. Paragraph [0059] of the present application is reproduced herein to provide added clarity to the Applicants' use of the term "virtual document":

"[0059] As described in detail hereinabove, a virtual document is generated by combining documents within a thread. A relation between the documents is reflected as a relation between sections in the virtual document, thereby enabling an easy grasp of the relation between the documents and obtaining a virtual document where only

documents in a required collection can be viewed at a time. More specifically, a relation between documents in a thread is extracted as a tree structure, for example, and a section group having the same tree structure is generated in a virtual document on the basis of the extracted tree structure before mapping of the relation between the documents. Thereafter, contents of documents corresponding to respective sections are mapped and displayed. In this manner, the mechanism for mapping a plurality of documents into a single virtual document is provided in this embodiment. The display in this embodiment is not a document list, but the content itself of the virtual combined document can be seen. Furthermore, even if a section is treated as an object embedded in a higher sentence as one in a nested structure, for example, relations between independent documents can be mapped into a single document without expanding a text of the higher document."

Consequently, based on the foregoing legal authorities governing the anticipation standard, claim 1 is not anticipated by Chang and the allowance of this claim and the claims dependent thereon is earnestly solicited.

Independent claims 26 and 34 are also allowable for containing a similar subject matter to that of claim 1. Therefore, claims 26 and 34 and the claims dependent thereon are also allowable.

CONCLUSION

All the claims presently on file in the present application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication would serve to advance

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prosecution of this case to finality, the Examiner is invited to call the undersigned at the below-listed telephone number.

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Respectfully submitted,

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